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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/669,904
Filing Date: September 24, 2003
Appellant(s): HARRINGTON, STEVEN J.

Michael J. Nickerson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/14/2007 appealing from the Office action mailed 05/23/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0066414 A1	Czerwinski et al.	04-2004
6,243,724	Mander et al.	06-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. **Claims 1, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czerwinski et al. (Pub No. US 2004/0066414 A1, hereinafter Czerwinski) in view of Mander et al (Patent No US 6243724 B1; hereinafter Mander).**

As to claim 1, Czerwinski teaches:

A method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device (i.e., a method for managing software application windows such as word processing program, see [0007] and [0003]), an opened document being an application invoked created area on the electronic desktop of the electronic device (i.e., each instantiated program is represented as one or more graphical windows displayed on the desktop portion such as control tiles 118, 120, 122, 124 corresponding to the instantiated programs 106, 108, 110, 112, see [0035] and [0036]), comprising:

(a) displaying a first icon associated with a first opened document in a predetermined form (e.g., item 118 in Fig. 1);

(b) displaying a second icon associated with a second opened document in the predetermined form (e.g., item 120 in Fig. 1);

(c) displaying a third icon associated with a third opened document in the predetermined form (e.g., icon 124 in Fig. 1; note that icons 118, 120, and 124 correspond to the instantiated programs that are displaying on the desktop, see [0037] and Fig. 1);

(d) selecting the first icon associated with the first opened document being displayed on the electronic desktop of the electronic device (i.e., selecting item 118, see Fig. 2A and [0037]);

(e) placing the first icon associated with the first opened document onto the second icon associated with the second opened document (e.g., placing item 118 onto item 120; note that a user can utilize traditional drag and drop functionality to select and group control tiles, see Fig. 2A and [0037]);

(f) modifying an appearance of the first icon associated with the first opened document to display an icon group showing the first icon as part of the icon group when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document (i.e., icon 118 is transformed into icon 126, see Fig. 2A; note that the group icon 126 may be represented solely by the group control icon 128 as shown in Fig. 5);

(g) displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon (e.g., see group icon 126 or icon 128 as shown in Fig. 2A and Fig. 5 respectively);

(h) selecting the third icon associated with the third opened document being displayed on the electronic desktop of the electronic device (e.g., selecting icon 124, see Fig. 3 and [0037]);

(i) placing the third icon associated with the third opened document onto the virtual pile icon (e.g., placing item 124 onto group icon 126, see Figs. 4, 7 and [0038]);

(j) modifying an appearance of the third icon associated with the third opened document to display the third icon as part of the icon group when the third icon associated with the third opened document is placed onto the virtual pile icon (e.g., see item 140 in Fig. 7); and

(k) modifying the appearance of the virtual pile icon (e.g., see item 140 in Fig. 7);

However, Czerwinski does not expressly teach that when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document, modifying an appearance of the first icon associated with the first opened document to display a first single line segment;

modifying an appearance of the third icon associated with the third opened document to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon

the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first opened document and the second single line segment representing the third icon associated with the third opened document thereunder;

Mander, though, teaches a method for organizing information in a computer system, particularly one having a graphical user interface which includes graphical representations of documents (e.g., see col. 2 lines 63-67; note that the graphical representations can be icon or can be any item or feature displayed on the display screen of the computer system, see col. 3 lines 1-5 and col. 7 lines 29-40; further note that the graphical representation may be a miniature of the first page of the actual document or an icon of the document type, a set of keywords related to the document or a set of attributes relating to the document, see col. 7 lines 1-8); wherein the method further allows a user to create a pile by selecting one graphical representation of a document and depositing on top of another graphical representation of a document (e.g., see col. 3 lines 5-20); Mander further teaches:

(f) modifying an appearance of the first icon associated with the first document to display a first single line segment when the first icon associated with the first document is placed onto the second icon associated with the second document (e.g., see Fig. 3; note that when icon 105

is placed onto icon 103, the appearance of icon 103 is modified to displayed a first single line segment; although icon 105 is considered the top icon of the pile, also displaying them in different position in the pile would not leave the scope and spirit of the disclose invention because Mander suggests to the skilled artisan that items or icon can be added anywhere into a pile such as in the middle of the pile, see col. 15 lines 15-22 and col. 37 lines 5-12).

(g) displaying a virtual pile icon representing a virtual pile when the first icon is placed onto the second icon, the virtual pile icon having an appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first document thereunder (e.g., see Fig. 3; note that pile 112 is created when icon 105 is placed onto icon 103; although icon 105 is considered the top icon of the pile, also displaying them in different position in the pile would not leave the scope and spirit of the disclose invention because Mander suggests to the skilled artisan that items or icon can be added anywhere into a pile such as in the middle of the pile, see col. 15 lines 15-22 and col. 37 lines 5-12);

(j) modifying an appearance of the third icon associated with the third document to display a second single line segment when the third icon associated with the third document is placed onto the virtual pile icon (e.g., note that the pile increase in height when a document is added to the pile, see col. 7 lines 35-40 and Fig. 4a); and

(k) modifying the appearance of the virtual pile icon, the virtual pile icon having the appearance of the second icon in the predetermined form with the first single line segment representing the first icon associated with the first document and the second single line segment representing the third icon associated with the third document thereunder (e.g., note that the pile shown in Fig. 4a includes more than 2 documents with the top icon having an appearance of the icon 105 in the predetermined form and single lines segments representing other icons

included in the pile; although the pile display in Fig. 4a having more than 3 documents, also displaying them with only 3 documents; that is the top document and other lines segment representing underneath documents would not leave the scope and spirit of the disclose invention because Mander suggests to the skilled artisan that a user can drag one document and place on top of another document or a pile to create a pile or to add a document to a pile, see col. 7 lines 35-40, col. 8 lines 47-59 and col. 37 lines 5-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Mander with the teaching of Czerwinski to achieve the claimed invention. The motivation for the combination is to provide a user the ability to organize information in a computer system to avoid the clutter problem.

As to claim 23, Czerwinski and Mander teach the limitations of claim 1 for the same reasons above. Czerwinski further teaches:

(I) providing information regarding an opened document in the virtual pile, when a mouse-over event is initiated upon the icon in the virtual pile representing the opened document (e.g., see Fig. 8 and [0046]).

(10) Response to Argument

Czerwinski reference: Czerwinski teaches a method for managing a plurality of opened documents being displayed on an electronic desktop of an electronic device (e.g., a method for managing software application windows such as word processing program, see [0007], [0003]), an opened document being an application invoked created area on the electronic desktop of the electronic device, the opened document displaying the contents of an electronic file (i.e., each instantiated program is represented as one or more graphical windows displayed on the desktop

portion such as control tiles 118, 120, 122, 124 corresponding to the instantiated programs 106, 108, 110, 112, see [0035] and [0036]). The method comprises displaying a first, second, and thirds icons associated with a first, second and third opened document, respectively, in the predetermined forms (e.g., note icons 118, 120, and 124 correspond to the instantiated programs that are displaying on the desktop, see [0037] and Fig. 1). The icons can be selected and placed onto other icons to create a group using traditional drag and drop feature (e.g., see Fig. 2A and [0037]). Upon placing a selected icon onto another icon, the appearance of the first icon is modified to display an icon group (e.g., note icon 118 is transformed into icon 126, see Fig. 2A; note that the group icon 126 can be represented solely by the group control icon 128 as shown in Fig. 5).

Mander reference: Mander teaches a method for organizing information in a computer system, particularly one having a graphical user interface which includes graphical representations of documents (e.g., see col. 2 lines 63-67; note that the graphical representations can be icon or can be any item or feature displayed on the display screen of the computer system, see col. 3 lines 1-5 and col. 7 lines 29-40; further note that the graphical representation may be a miniature of the first page of the actual document or an icon of the document type, a set of keywords related to the document or a set of attributes relating to the document, see col. 7 lines 1-8); wherein the method further allows a user to create a pile by selecting one graphical representation of a document and depositing on top of another graphical representation of a document (e.g., see col. 3 lines 5-20; note graphical representations of a document is shown as icons). The method further comprises upon placing a selected icon and depositing on top of another icon, modifying the appearance of the underneath icon to display a single line segment and to show a pile (e.g., see Fig. 3). Mander further teaches that icons can

be added anywhere into a pile such as in the middle of the pile, see col. 15 lines 15-22 and col. 18 lines 49-53).

The arguments:

I. The appellants argue (Appeal Brief dated 11/14/2007 at page 8, second paragraph) that:

Although Czerwinski et al. teaches the creation of a group icon, the individual icons, which created the group, are **not** modified in appearance, but remain unchanged. Thus, Czerwinski et al. fails to teach or suggest that an appearance of the first icon associated with the first opened document is modified to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document and/or an appearance of the third icon associated with the third opened document is modified to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon.

In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the combination of Czerwinski and Mander clearly teach the limitation of "an appearance of the first icon associated with the first opened document is modified to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document and/or an appearance of the third icon associated with the third opened document is modified to display a second single line segment when the third icon associated with the third opened document is placed onto the virtual pile icon", addressed *supra*. In addition, it is noted that the features upon which applicant relies (i.e., the individual icons which created the group)(emphases added) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

II. The appellants argue (Appeal Brief dated 11/14/2007 at page 9, paragraphs 3)

that:

It is readily apparent from the Examiner's remarks that the Examiner recognizes that Mander et al., on its face, fails to disclose or suggest modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon. Notwithstanding, the Examiner is apparently asserting that somewhere in the nebulous and undefined realm of the "scope and spirit" of Mander et al., one of ordinary skill in the art would stumble upon a suggestion to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

The examiner respectfully submits that, Mander clearly suggests the limitation of "modifying an appearance of the first icon associated with the first document to display a first single line segment when the first icon associated with the first document is placed onto the second icon associated with the second document" (e.g., see Fig. 3 and col. 8 lines 47-67 through col. 9 lines 1-21; note that when icon 105 is placed onto icon 103, the appearance of icon 103 is modified to displayed a first single line segment; further note that when icon 105 is added in the middle of the pile, this would meet the claimed invention because Mander suggests to one of ordinary skill in the art at the time the invention was made that icons can be added anywhere into a pile such as in the middle of the pile, see col. 15 lines 15-22 and col. 18 lines 49-53).

III. The appellants argue (Appeal Brief dated 11/14/2007 at page 9, paragraphs 4)

that:

The Examiner is relying upon an unknown or undefined entity when the Examiner asserts that that "within the scope and spirit of the disclosed invention," Mander et al. suggests modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon. If this "scope and spirit" of Mander et al. is a quantifiable and definable entity, it is respectfully requested that the Examiner provide documented evidence demonstrating the boundaries of the "scope and spirit" of the disclosed invention of Mander et al.

The examiner respectfully submits that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In this case, Mander clearly suggests to a skilled artisan the limitation of "modifying an appearance of the first icon associated with the first document to display a first single line segment when the first icon associated with the first document is placed onto the second icon associated with the second document" (e.g., see Fig. 3 and col. 8 lines 47-67 through col. 9 lines 1-21; note that when icon 105 is placed onto icon 103, the appearance of icon 103 is modified to display a first single line segment; further note that when icon 105 is added in the middle of the pile, this would meet the claimed invention because Mander suggests to one of ordinary skill in the art at the time the invention was made that icons can be added anywhere into a pile such as in the middle of the pile, see col. 15 lines 15-22 and col. 18 lines 49-53).

IV. The appellants argue (Appeal Brief dated 11/14/2007 at page 10, paragraphs 1) that:

It is respectfully submitted that the Examiner's reliance upon an alleged suggestion "within the scope and spirit of the disclosed invention" is outside the scope of a proper analysis of obviousness under 35 U.S.C. 103.

The examiner again respectfully submits that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also

FIG. 3

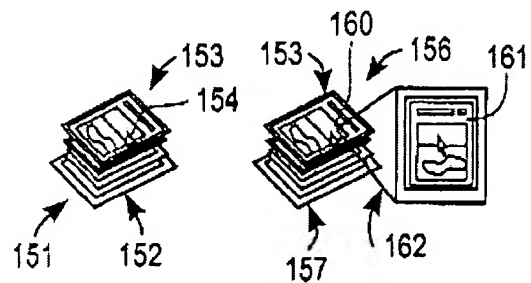


FIG. 4a

As can be seen from Figure 3 and Figs. 4a and associating text from col. 8 lines 47-67 through col. 9 lines 1-21, when an icon (e.g., icon 105) is selected and placed over another icon, the appearance of the another icon is (e.g., icon 103) is modified to display a single line segment. In addition, as described and suggested from Figure 4a and col. 15 lines 15-22 and col. 18 lines 49-53, an icon can be added into a pile anywhere other than the top position, in this case, the added icon's appearance can be modified to display a single line; this would read on

the claimed limitation. Therefore, it would have been obvious to one of ordinary skill in the art to implement the limitation of "modifying an appearance of the first icon associated with the first document to display a first single line segment when the first icon associated with the first document is placed onto the second icon associated with the second document"; and this would not leave the scope and spirit of Mander's disclosed invention.

V. The appellants argue (Appeal Brief dated 11/14/2007 at page 10, paragraphs 2) that:

As recognized by the Examiner, the plain teachings of Mander et al. disclose that the virtual pile's appearance is modified to reflect the icon of a first document when the first icon is placed onto the virtual pile. Notwithstanding this explicit teaching, the Examiner asserts that since Mander et al. teaches modifying the appearance of the first icon associated with the first document when the first icon is placed within the virtual pile (Mander et al. teaches that when the icon associated with the first document is placed within the virtual pile, the icon associated with the first document is changed), one of ordinary skill in the art would discover a suggestion to modify an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon.

In response, the examiner respectfully submits that contrary to what the Appellants' remark, the examiner, in the Office Action dated 05/23/2007, page 5, second paragraph, recognizes that the limitation of "modifying an appearance of the first icon to display a first single line segment when the first icon is placed onto the second icon" is taught by Mander reference. In addition, the examiner would like to point out that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

VI. The appellants argue (Appeal Brief dated 11/14/2007 at page 10, paragraphs 3, 4) that:

This placement requires more than dropping the icon of the document onto the icon of the virtual pile. Mander et al. teaches that to place the icon associated with the first document within the virtual pile, the icon of the document is held over the virtual pile until the pile is partially de-stacked to show the user various available locations in which the icon can be placed. If the user desires a different location within the stack, Mander et al. teaches that a movement of the cursor will create another location or set of locations for placing the icon. Once the location is selected, Mander et al. teaches that the user releases the icon to that location within the pile.

In response to Appellants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the placement requires more than dropping the icon of the document onto the icon of a virtual pile) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

VII. The appellants argue (Appeal Brief dated 11/14/2007 at page 11, paragraph 5) that:

Since Czerwinski et al. and Mander et al. each singly fails to teach or suggest a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document, the combined teachings of Czerwinski et al. and Mander et al. fail to teach or suggest a method that modifies an appearance of the first icon associated with the first opened document to display a first single line segment when the first icon associated with the first opened document is placed onto the second icon associated with the second opened document.

In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, "[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take

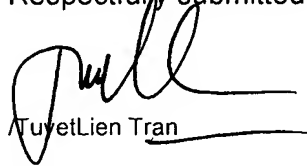
account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Patent Examiner
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January 9th, 2008

Conferees:



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